

REMARKS

Claims 1 and 3-6 are pending and under consideration, and the Office Action has rejected claims 1 and 4-6. The rejections are traversed and reconsideration of all claims is respectfully requested.

REQUEST FOR WITHDRAWAL OF FINALITY

Withdrawal of the finality of the outstanding Office Action is respectfully requested. It is respectfully submitted that the outstanding rejections fail to meet a prima facie obviousness standard, necessitating a issuance of a new Office Action properly reasserting the same.

Applicants respectfully submit that the Office Action has failed to provide any concrete evidence for the recited motivation to combine U. S. Patent 5,699,431 issued to Van Oorschot et al.(hereinafter referred to as "Oorschot"), U.S. Patent 5, 717,758 issued to Micali (hereinafter referred to as "Micali "), U.S. Patent 6,487,658 issued to Micali (hereinafter referred to as "Micali II"), and U.S. Patent Publication 2002/0188843 A1 to Kocher, and thereby, fails to meet its burden in providing a prima facie case for an obviousness rejection under 35 U.S.C. §103(a).

For example, Page 4 of the Office Action asserts,"... it would have been obvious ... to combine the teachings of Micali II, and the combination of Van and Micali because SCRL mechanism would minimize the amount of 'unwanted information' for each of the above queries, and reduce downloading time."

In another example, Page 5 of the Office Action asserts,"... it would have been obvious ... to employ the teachings Kocher within the combination system of Van, Micali, and Micali II, because it would allow to produce distribution levels."

In both of these examples, the Office Action merely refers to results of combining references without discussing why one of ordinary skill in the art at the time of the invention would have been motivated to combine these references. The underlying motivational rationale are merely subjective beliefs, rather than the required objective concrete evidence in the record, i.e., they are merely conclusions without support.

It is well settled that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding or experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by

clarifying that the principles of "common knowledge" and "common sense" may only be applied to the analysis of evidence, rather than be a substitute for evidence. The court has also recently expanded their reasoning on this topic in In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

Accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings. The mere fact that the prior art may be modified in a particular manner does not make the modification obvious unless the prior art suggested the desirability of that modification.

Accordingly, Applicants respectfully request withdrawal of the finality of the Office Action as the Office Action fails to meet the prima facie burden required by 35 U.S.C. §103.

REJECTION UNDER 35 U.S.C. §103:

The Office Action has rejected claims 1 and 3-6 under 35 U.S.C. §103(a) as being unpatentable over Oorschot in view of Micali, in further view of Micali II, and further in view of Kocher. This rejection is respectfully traversed.

Oorschot, Micali, Micali II, and Kocher, taken separately or in combination, do not disclose, teach, or suggest at least, "setting the value of the variable (crl_dp_flag) for the CRL according to the distribution interval," as recited in independent claims 1 and 6.

Page 4 of the Office Action notes, "Van [Oorschot] and Micali fail to explicitly describe setting the value of the variable (crl_dp_flag) for the CRL according to the distribution interval." The Office Action also asserts that Micali II discloses this feature in Col. 10, line 58 - col. 11, line 28. However, Col. 10, line 58 –col. 11, line 28 of Micali II does not refer to the "setting the value of the variable (crl_dp_flag)." In fact, Micali II does not refer to the use of a flag at all.

Moreover, the Office Action asserts that defining the number of nodes in the directory information tree (DIT) based on the number of expected subscribers is obvious. However, as noted above, a publication in support of this assertion has not been supplied. Therefore, Applicants respectfully request withdrawal of this assertion or request a publication, or something concrete in the record, that supports this assertion.

Aging as submitted above, it is respectfully submitted that the outstanding Office Action also fails to set forth a prima facie obviousness case.

Therefore, for at least these reasons, it is respectfully submitted that claims 1 and

6 patentably distinguishes from the cited references.

Claims 3-5 depend from claim 1 and include all of the features of that claim plus additional features, which are not taught or suggested by the cited references. For example, the cited references do not disclose the skipping function in claims 3 and 5, and "preparing a phrase...according to the subject name," as recited in claim 4. Therefore, for at least these reasons, it is respectfully submitted that claims 3-5 also patentably distinguish over the cited references.

CONCLUSION:

Claims 1 and 3-6 are pending and under consideration. It is respectfully submitted that none of the cited references taken separately or in combination disclose the present invention.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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